

REMARKS

Reconsideration and withdrawal of the rejections to this application are respectfully requested in view of the following amendments and remarks which place the application into condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 19-70 are pending. Claims 1-18 are cancelled and claims 19-70 are added, without prejudice, to advance prosecution and to place the claims in condition for allowance.

No new matter has been added.

The amendments and the remarks made herein are not made for reasons related to patentability and, thus, do not prevent the application of the doctrine of equivalents. Support for the amended recitations in the claims and for the new claims are found throughout the specification and from the pending claims. Support for new claims 19-70 is found in the cancelled claims.

II. CLAIM OBJECTIONS

Claims 4-13, 16 and 17 were objected to under 37 C.F.R. §1.75(c) as allegedly being in improper form; and claims 13, 16 and 18 were objected to as allegedly being drawn to a non-statutory class of invention. The objects are traversed.

The cancellation of claims 1-18, and the addition of new claims 19-70, render the objections moot. Consequently, reconsideration and withdrawal of the objections to the claims are respectfully requested.

III. 35 U.S.C. §103 REJECTIONS

Claims 1-3, 14 and 15 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over PCT WO 96/41537 to Hacker et al. in view of U.S. Patent No. 6,451,737 to Gesing et al. and U.S. Patent No. 6,413,911 to Mayer et al. The rejection is traversed. None of the cited documents teach, suggest or motivate a skilled artisan to practice the instant invention.

More specifically, in order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Against this background, none of the cited documents, either alone or in combination, teaches, suggests or discloses the instantly claimed invention. The present invention is directed to formulations and compounds of specific phosphonium and sulfonium salts of sulfonylureas. None of the cited documents teach, suggest or motivate a skilled artisan to practice the instant invention.

Moreover, it was surprisingly and unexpectedly discovered that the instantly claimed sulfonylurea salts could be formulated in various ways, e.g., as liquid formulations, such as EC-formulations, or as solid formulations, such as WG-formulations (*see* page 34 of the instant specification). In contrast thereto, neutral sulfonylureas or their metal salts, as purported in the documents relied upon in the Office Action, cannot be formulated with such flexibility. This is disclosed, for example, in the Examples at pages 35 and 36 of the instant invention, and also shown in the Declaration of Dr. Gerhard Schnabel, submitted herewith.

Therefore, the instant invention exhibits unexpected results and superiority over the art and, thus, rebuts any holding of *prima facie* obviousness. The results presented in the instant specification, and in Dr. Schnabel's Declaration, were unexpected and provide evidence of the superiority of the instant invention over the cited art. Therefore, even if it was so held that a person with ordinary skill in the art would have been motivated to practice the instant invention from a reading of the cited art, a point Applicants do not concede, the instant specification, the declaration submitted herewith and the conclusions contained therein clearly rebut such a holding since the cited art does not suggest that Applicants' invention would exhibit such superior and unexpected results. The claimed invention, therefore, is unobvious.

Further, that the Federal Circuit in *In re Fine* was very clear that "obvious to try" is not the standard upon which an obviousness rejection should be based. And as "obvious to try" would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law.

Therefore, reconsideration and withdrawal of the Section 103 rejections based on the preceding documents are respectfully requested.

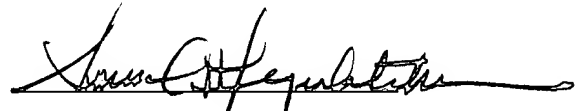
CONCLUSION

In view of the amendments and remarks herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance, or an interview at a very early date with a view to placing the application in condition for allowance, are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date.

Respectfully submitted,

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